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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 14

Application Number: 09/321,387
Filing Date: 05/27/99
Appellant(s): HENDERSON et al.

Glenn Synder
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 04/05/2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 13, 28, 29 and 30 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,487,107	ATKINS ET AL.	01/23/1996
5,592,537	MOEN	01/07/1997

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5,912,956	LONGO ET AL.	06/15/1999
5,963,626	NABKEL	10/05/1999
6,009,150	KAMEL	12/28/1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Longo et al. (US Pat# 5,912,956) in view of Atkins et al. (US Pat# 5,487,107).

Regarding claim 9, Longo teaches a communication system for recording at least one message associated with a pre-paid card comprising of a data storage system (see 24 of fig. 1) which stores services associated with a prepaid calling card;

a voice processing system (26 of fig. 1) configure to receive a request to record a message meant for another over a network during a service setup call associated with the prepaid card (see Prompts 9&11 of fig. 7, fig. 9, column 4 lines 42-44, and column 6 lines 18-25) during authentication associated with the account;

during authentication of a card, services associated with the pre-paid card can be determined wherein the services including recording a message, recharging the pre-paid card, speed dialing, making a phone call and so forth can be activated (see fig. 7) by means of prompts.

Longo teaches all the claimed subject matter except that during a call, if the authentication information associated with a service request happens to be different from the conventional information associated with the service, directing the caller to a first telephone number.

It's well known in the art to inform a user to contact a customer service center if a requested service can not be provided based on authentication information used in determining if a customer has subscribed to the requested service or made pre-arrangements with a service provider. Furthermore, it's well known that some prepaid cards are used solely for making

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prepaid calls which would be recognized by the system during authentication after which the caller can be advised to input "the telephone number of the party you are trying to call"

An example is when a user calls an automated account verification system associated with a credit card vendor wherein if a user's information happens to be inaccurate or has problem with the service setup, one can be informed to hold on while they are transferred to a customer service representative or could be press "0" or could be given a customer service telephone number to call to request a wanted service.

Atkins teaches a method and apparatus for processing telephone calls charged to debit cards, credit cards and so forth wherein a user could be given the customer service telephone number (see column 6 lines 34-36) if authentication for a requested service was unable to be performed. Furthermore, a customer can automatically be connected to a customer service center personnel (see column 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Atkins et al. into that of Longo et al. thus informing users to contact customer service during authentication of a requested service if a requested task is unable to be performed due to inaccurate information or a caller not being eligible for the service because he/she has not subscribed to the requested service to expedite a service request.

Regarding claims 10-11, The combination teaches debiting a "prepaid account" based on usage (see 108 of fig. 7 and column 5 lines 49-61 of Longo).

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Regarding claim 12, The combination teaches being able to record a message in conjunction with a prepaid card account identified by its unique identifier (see column fig. 7, section "106" and prompt# 9 and 11 of Longo et al.).

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Longo (US Pat# 5,912,956) in view of Atkins et al. (US Pat# 5,487,107) and further in view of Kamel (US Pat 6,009,150).

Regarding claim 13, The combination teaches that one has to press a prompt (manual activation) to hear a playback message during an access call but fails to teach automatic playback during call setup.

Kamel teaches a call processing method for delivering promotional messages wherein messages can automatically be relayed to a user given that a PIN is verified and valid or automatically inserting messages during a call as being well known (see column 6 lines 23-29, column 3 lines 51-60). Furthermore, Kamel teaches that during authentication, a call can be directed to a customer service telephone number if there is a problem during authentication (see 216 of fig. 2A).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Kamel into the combination thus making it possible to automatically deliver messages to a user after authentication and verification of one's account information without having to request it manually.

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9. Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Longo et al. (US Pat# 5,912,956).

Regarding claim 28, Longo teaches a communication system for recording at least one message associated with a pre-paid card comprising of a data storage system (see 24 of fig. 1) which stores services associated with a prepaid calling card and a voice processing system (26 of fig. 1) configure to receive a request to record or playback a message meant for another over a network during a service setup call (see Prompts 9& 11 of fig. 7, fig. 9, column 4 lines 42-44, and column 6 lines 18-25). Longo teaches a pre-paid account wherein one can record or playback messages in conjunction with the account, recharge the account and so forth thus making the prepaid calling card taught by Longo a "special card" with a variety of features. Longo fails to teach that the system would be capable of receiving and servicing prepaid calling cards used solely for making calls in addition to the taught prepaid cards with the customized features (message capability, recharging the card, speed dialing and so forth). Prepaid cards solely used for making calls to a called party reads on initiating a call in response to the call access request if the prepaid card does not comprise an audio message type calling card.

The examiner takes official notice that usage of prepaid calling cards solely meant for making telephone calls and nothing else is well known in the art without recharging capabilities. Cards such as EconoLo, Exclusive, DMV, Global connect and so forth are some of the cards which are used in making solely for making telephone calls. In summary, most communication

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systems do accommodate a plurality of pre-paid cards, from different vendors, used in making user telephone calls

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made that depending on the services associated with a prepaid card as designed by the prepaid card vendor(s), one might/might not be eligible for a plurality of services such as recharging one's card and so forth thus making the card only eligible for making calls, a fact notoriously well known in the art, which enables users to make telephone calls from other locations other than one's customer premises.

Regarding claim 29, Longo teaches a communication system for recording at least one message associated with a pre-paid card comprising of a data storage system (see 24 of fig. 1) which stores services associated with a prepaid calling card and a voice processing system (26 of fig. 1) configure to receive a request to record or playback a message meant for another over a network during a service setup call (see Prompts 9& 11 of fig. 7, fig. 9, column 4 lines 42-44, and column 6 lines 18-25). Longo teaches a pre-paid account wherein one can record or playback messages in conjunction with the account, recharge the account and so forth thus making the prepaid calling card taught by Longo a "special card" with a variety of features. Longo fails to teach that the system would be capable of receiving and servicing prepaid calling cards used solely for making calls in addition to the taught prepaid cards with the customized features (message capability, recharging the card, speed dialing and so forth). Prepaid cards solely used for making calls to a called party wherein a user is prompted to input the telephone number of the called party

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“general message” which is not unique to prepaid account code/identifier reads on “initiating playback of an audio message unaffiliated with the prepaid telephone calling card if the et least one audio message has not previously been stored

The examiner takes official notice that usage of prepaid calling cards solely meant for making telephone calls and nothing else is well known in the art without recharging capabilities. Cards such as EconoLo, Exclusive, Global connect and so forth are some of the cards which are used in making solely for making telephone calls. A caller is prompted to input the telephone number of the called party if there is enough balance in the account to make the call, notoriously well known.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made that depending on the services associated with a prepaid card as designed by the prepaid card vendor(s), one might/might not be eligible for a plurality of services such as recharging one's card and so forth thus making the card only eligible for making calls, a fact notoriously well known in the art, which enables one to make telephone calls from other locations other than one's customer premises.

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2. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Longo et al. (US Pat# 5,912,956) in view of Nabkel (US Pat# 5,963,626).

Regarding claim 30, Longo teaches a communication system for recording at least one message associated with a pre-paid card comprising of a data storage system (see 24 of fig. 1) which stores services associated with a prepaid calling card and a voice processing system (26 of fig. 1) configure to receive a request to record or playback a message meant for another over a network during a service setup call (see Prompts 9& 11 of fig. 7, fig. 9, column 4 lines 42-44, and column 6 lines 18-25). Longo teaches a pre-paid account wherein one can record or playback messages in conjunction with the account, recharge the account and so forth thus making the prepaid calling card taught by Longo a "special card" with a variety of features. Longo teaches all the claimed subject matter except deleting a stored messages after it's been played back a number of times.

Deleting a message after it's being listened to a number of times is known in the art.

However, Nabkel teaches a method and system for posting messages to callers wherein a message can expire after it's been played back to a number of people in a list (see column 3 lines 34-42) a number of times possibly equivalent to the number of people.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Nabkel into that of Longo thus making it possible to delete or erase a message after it's been listened to, a number of times in order to save memory space.

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11. Claims 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Longo in view of Moen (US Pat# 5,592,537).

Regarding claims 31-32, Longo teaches a system and method for anonymously establishing a telephonic connections comprising of a prepaid account system for receiving a call access request (figs. 2-4, fig. 7), providing services which includes recording or playback of a message in conjunction with an account identifier after being queried by an automated attendant to do so via a prompt (see prompts #9, 11 of fig. 7 and fig. 9).

Thus, in general, Longo teaches being able to store any "general message" desired by a party in response to a prompt requesting recording of a message wherein the message could be played back to another caller/party during a subsequent call.

Longo fails to teach recording a message specific to a "a purchase preference" which according to the specification could be a message such as "please get me a toy" or could be a Christmas wish list and so forth.

Moen teaches a method of providing message service for limited access telecommunications wherein a plurality of messages including commercial, religious, product promotions, personal messages and so forth can be recorded in conjunction with a prepaid account (see column 2 line 54-column 3 line 17 and figs. 1-3)..

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of Longo and Moen to record any desired message in conjunction

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with a prepaid account for a subsequent playback thus making a caller or account owner aware of any emergencies or request or needed information.

(11) Response to Argument

3. Applicant's arguments filed on 04/05/01 have been fully considered but they are not persuasive.

The appeal brief filed by the applicant on 04/05/01 contains the following arguments.

REGARDING CLAIM 9

In regard to independent claim 9, the appellant argued that “determining that a prepaid calling card comprises a first type of card based on an access code and if the prepaid card does not comprise the first type of card directing a caller associated with the service setup call to call a first telephone number” is not taught by the prior art of record or could not be rendered obvious by the combination set forth in the explanation of the rejection of the claimed subject matter.

The examiner disagrees because Longo teaches a prepaid calling card system wherein a card is authenticated after which the user can be prompt to select one of a plurality of services associated with the card which includes recording a message, playback of a message, recharging/replenishing one's account, speed dialing and so forth. Thus, the features including recording/playback would be activated based on dialed access code and validated PIN associated with the prepaid calling card/account being used which reads on “determining that a prepaid calling card comprises a first type of calling card based on an access code”. If the prepaid card does not comprise the first type of card directing a caller associated with the service setup to call

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a first telephone number could be construed as “receiving digit inputs or DTMF signaling entered by a user” different from information conventionally associated with the service setup request. It’s notoriously well known in the art to receive information from a customer or caller different from standard information during a service request wherein the caller/customer can be directed to a first telephone number which in this case would read on directing a call to a customer service center if the system does not recognize the entered digits. The examiner supplemented the teaching of Longo with the teaching of Atkins, a reference directed to alternatively routing a call or informing a caller to call/contact a customer service number when received input information makes it impossible to setup a service if the system does not recognize the information. Notice, it’s proper and permissible to make this assertion “customer service bailout” given the fact that Longo teaches a customer service system (see fig. 7).

A first type could read on a valid information associated with a prepaid calling card/account thus making it possible to provide a calling customer with one of a plurality services and if the information happens to be invalid, directing the caller to call a first telephone number (customer service number).

The appellant, also, argued that the primary art of record Longo is directed to a calling card while the secondary reference is directed to a credit card and would not be obvious to combine the references because there would be no motivation to do so.

The examiner strongly disagrees because they are both directed to a telecommunication environment/system for making telephone calls after authentication of an access telephone number

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and PIN. Furthermore, they are functionally equivalent in the sense that one can make long distance, local calls and so forth with the exception of one having a threshold limit (prepaid calling card/account). The appellant has attached the references individually when the explanation was based on the rejection as set forth regarding claim.

In response to appellant's argument that it would not be obvious to make the combination set forth in the rejection of independent claim 9, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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REGARDING CLAIM 13

First of all, Longo teaches playing back a stored message to a customer or user after manually requesting to listen to the stored message in this case by selecting a prompt associated with the service. Thus, the examiner supplemented the teach of Longo and Atkins with that of Kamel to teach the possibility of automatic playback of at least one recorded message during call set up.

The appellant argued that Kamel, secondary reference, fails to teach automatically playback of at least one message during an access call related to the prepaid telephone calling card

Eventhough, the system taught by Kamel is not directed to a prepaid system, it teaches a message playback system wherein at least one stored message can automatically be played back to a user after authentication of the user in this case validation of PIN (see column 6 lines 23-29, column 3 lines 51-60, fig. 2, column 4 lines 44-55).

Therefore, the explanation as set forth in the rejection of the claimed subject is believed proper and permissible on the basis that it would have been obvious to one of ordinary skill in the art to relay stored information to a caller either after requesting it manually or to do so by a voice storage system automatically for “at least one message” after call authentication of a PIN

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REGARDING CLAIM 28

The appellant argues that the prior art of record (Longo) fails to teach determining if a prepaid telephone calling card is an audio message calling type.

The examiner disagrees because features such as recording and playback of a stored message can only be activated if and only if the access code and PIN are successfully validated based on its stored records wherein records includes services such as service prompts associated with the prepaid calling card by the telecommunications system. Note that a plurality of services including speed dialing, recharging of a prepaid account, message storage, playback of a message and so forth are all featured provided by the prepaid card as designed by the card vendor in conjunction with a telecommunication service carrier or provider.

The examiner rejected the claimed subject matter on the grounds that a telecommunication service carrier provides communication services in conjunction with a plurality of different card vendors including various calling card vendors, prepaid calling card vendors and so forth. Prepaid cards, used solely for making calls are notoriously well known in the art whereas the prepaid card taught by Longo is capable of providing other special services including Messaging services, speed dialing, replenishing/recharging of one's account and so forth. The fact that Longo teaches a specialized card does not mean that a general system would be incapable of communicating with prepaid card issuers whose cards are used solely for making cards and then connecting a calling party to a called party if there is enough money in the account to do so. Thus, in summary, the services associated with a prepaid calling card would be based partly based on the prepaid vendor

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issuing the card and since, all prepaid cards are not restricted to the service features taught by Longo, it would have been obvious to incorporate the teaching of having a plurality of prepaid calling cards with different features and/or in the conventional prepaid calling card since most communication systems do accommodate a plurality of different prepaid calling cards.

Thus in summary, the limitation “initiating a call in response to the call access request if the prepaid telephone calling does not comprise an audio message type calling card” can be construed as simply activating a “call connect or call set up” to a called party in the conventional sense of prepaid systems used solely in completing a call and debiting the account based on call duration and so forth.

REGARDING CLAIM 29

The appellant argues that the prior art of record (Longo) fails to teach determining if a prepaid telephone calling card is an audio message calling type.

The examiner disagrees because features such as recording and playback of a stored message can only be activated if and only if the access code and PIN are successfully validated based on its stored records wherein records includes services/features associated with the prepaid calling card by the telecommunications system. Note that a plurality of services including speed dialing, recharging of a prepaid account, message storage, playback of a message and so forth are all featured provided by the prepaid card as designed by the card vendor in conjunction with a telecommunication service carrier or provider.

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The examiner rejected the claimed subject matter on the grounds that a telecommunication service carrier provides communication services in conjunction with a plurality of different card vendors including various calling card vendors, prepaid calling card vendors and so forth. Prepaid cards, used solely for making calls are notoriously well known in the art whereas the prepaid card taught by Longo is capable of providing other special services including Messaging services, speed dialing, replenishing/recharging of one's account and so forth. The fact that Longo teaches a specialized card does not mean that a general system would be incapable of communicating with prepaid card issuers whose cards are used solely for making cards and then connecting a calling party to a called party if there is enough money in the account to do so. Thus, in summary, the services associated with a prepaid calling card would be based partly based on the prepaid vendor issuing the card and since, all prepaid cards are not restricted to the service features taught by Longo, it would have been obvious to incorporate the teaching of having a plurality of prepaid calling cards with different features and/or in the conventional prepaid calling card since most communication systems do accommodate a plurality of different prepaid calling cards.

Thus in summary, the limitation "initiating playback of an audio message unaffiliated with the prepaid calling if the at least one audio message has not been previously stored" can be construed as simply activating a "call connect or call set up" to a called party in the conventional sense of prepaid systems used solely in completing a call and debiting the account based on call duration and so forth wherein the user is advised usually with a general statement such as "input

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the telephone number of the party you want to call, now". In other words, playback of a message not specific to the calling card account or stored specifically in conjunction with the account.

REGARDING CLAIM 30

The appellant argued that the combination as set forth in the rejection of independent claim 30 fails to teach "determine a number of times the at least one message has been played and then deleting the at least one message from the data storage system responsive to the determination".

It's known in the voice Messaging art to delete a message after it's been listened to, a couple of times.

The combination teaches deleting a message after it's been listened to, a number of times. The combination teaches that a message can be stored for a plurality of party on a list who would call in to listen to the message, after all the people on the list have listened to the message, it could expire (see column 3 lines 34-36). In summary, after a stored message has been listened to a number of times equivalent to the number of people on a list, a message would expire. The combination is believed proper and permissible because both system are directed to a telephony system and voice messaging in response to applicant's suggestion that it would not be obvious to combine these references.

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REGARDING CLAIMS 31 AND 32.

Longo teaches in the broadest sense, a system directed to a prepaid calling system wherein a user can make a telephone call in the conventional sense and also, be able to record a general message as desired for a party in possession of the account information.

Moen teaches a prepaid account system for making telephone calls wherein messages including promotional, religious, personal and so forth can be recorded in conjunction with a prepaid account for subsequent playback to a prepaid account holder.

The appellant argued that the primary prior art of record fails to request from a user a purchase preference of a user which can be recorded and then playback to an account holder. Thus, the appellant's argument centers on the fact that the message recorded by Longo is not specific to a "purchase preference" which according to the specification could include a statement such as "please, get or buy me a toy" and so forth.

Arguably, it would have been obvious to use Longo solely in the explanation as set forth in the rejection of the claimed subject matter since Longo does not put a restriction on the type of message which could be recorded because it would be done on an individual basis by a plurality of users serviced by the communication network. However, the examiner supplemented the primary prior art of record with a secondary reference (Moen) to show that the ability to record a specific message including personal, promotional, religious and so forth is not in fact unique to Longo but known in the art. Thus, whatever message one decides to record in conjunction with the prepaid account would in fact be based on one's personal decision, needs, desire and so forth.

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The prior art of record (Moen) according to the appellant's argument would limit a user trying to access a preset message if it's already being accessed by the same predetermined PIN being used in requesting to listen to the preset message.

The number of times, a user is permitted to listen to a message using a predetermined PIN is not directed to the claimed subject matter.

The appellant's argued that it would be not be to one of ordinary skill in the art to make the combination used in the explanation as set forth in the rejection of the claimed subject matter.

The examiner strongly disagrees because they are both directed to a telephone system in conjunction with a voice message recording apparatus wherein messages can be stored in conjunction with a prepaid account.

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CONCLUSION

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
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September 28, 2001

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